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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,747	10/24/2000	Roger D Melen	4863(CFP1587US)	1555
5514	7590	07/13/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 07/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,747

Applicant(s)

MELEN ET AL.

Examiner

Mary Cheung

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Request for Continued Examination

1. The request filed on May 21, 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/695,747 is acceptable and a RCE has been established.
2. Claims 1-38 are pending. Claims 1, 8, 10, 19-20, 24 and 38 have been amended.

Response to Arguments

3. Applicant's arguments filed April 2, 2004 have been fully considered but they are not persuasive.

The applicant argues that Barker (U. S. Patent 6,233,252) does not teach "indirect reference". Examiner respectfully disagrees because the numbers or the orders that assigned to the fragmented files correspond to the indirect reference (column 3 lines 25-62).

In response to applicant's argument that Barker fails to disclose the notification to a recipient with an indirect reference, examiner has revised the rejection that shows Miller (U. S. Patent 6,151,696) teaches this limitation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-5, 8-10, 17, 21-30 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Miller et al., U. S. Patent 6,151,696.

As to claim 1, Barker teaches a method for controlling a server in order to distribute document folders (document fragments or large size documents) to recipients, wherein the server is a member of system that includes at least one sending device, a plurality of servers, and at least one receiving device, said method comprising (abstract and Fig. 1):

a) Temporarily storing an electronic document folders sent from the sending device, the electronic folder comprising at least one document is taught by Barker as a large size document or document fragments are sent from a sending device, the large size document comprising at least one document fragment, and said document fragments are later to be reconstructed to the original scheme (column 2 line 53 – column 3 line 29 and Fig. 1);

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- b) Receiving by a recipient of the electronic document folder with an indirect reference, the indirect reference being usable to identify the electronic document folder intended for said recipient is taught by Barker as a recipient receives document fragments, and each document fragment has an indirect reference and the indirect reference being used for identifying and reassembling the document fragments (column 3 lines 26-62);
- c) A destination sever can be access from the receiving device of the recipient (column 3 lines 4-19);
- d) Accumulating the temporarily stored document fragments at the selected destination server, wherein the receiving device of the recipient can retrieve the accumulated electronic document folder from the destination server via a network based on the indirect reference (column 3 lines 4-19, 52-62 and Fig. 2).

Barker does not specifically teach notifying the recipient of the electronic document folder with an indirect reference, and selecting a destination server based on data provided by said recipient, the data including information with regard to the destination server designated by the recipient. However, Miller teaches this matter (column 6 lines 9-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Barker's teaching to include the features of notifying the recipient of the electronic document folder with an indirect reference, and selecting a destination server based on data provided by said recipient, the data including information with regard to the destination server designated by the recipient for ensuring the reception of the data.

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As to claims 2-4, Barker teaches a method for distributing document fragments to recipients as discussed above. Barker does not explicitly teach the data provided by the recipient is selected from the group consisting of document reception address data and additional document reception data. However, Miller teaches the data provided by a recipient consisting of document reception address data and additional document reception data (column 4 lines 12-16 and column 6 lines 30-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data provided by the recipient in Barker to include document reception address data and additional document reception data so that the document fragment can be better distributed to the recipients.

As to claim 5, the indirect reference to the electronic document folder comprises a folder code containing information needed to retrieve the electronic document folder is taught by Barker as the indirect reference to the document fragment containing information needed for retrieving the document (column 3 lines 26-30, 58-62).

As to claim 8, Barker teaches modifying (fragmenting) data for the best recipient use with regard to capabilities of a receiving device at said destination server (abstract and column 3 lines 26-29).

As to claim 9, Barker teaches a method to securely distribute document fragments to recipients as discussed above. Barker does not specifically teach sending acknowledgment to a sender. However, Miller teaches this matter (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to send acknowledgment to a sender because it would

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allow the sender to know the status of the transmitted documents so that the documents would be transmitted more efficiently.

As to claim 10, Barker teaches a recipient retrieving the electronic document fragment based upon providing information contained in said indirect reference (column 3 lines 26-29, 58-62).

As to claim 17, Barker does not explicitly teach the document folders are sent using virtual private network security. It would have been obvious to one of ordinary skill in the art to allow the method document folders to Barker to be sent through virtual private network security because this commonly used network system would allow the user securely transferring information.

As to claims 21-22, Barker does not explicitly teach sending a notification via email or over a cellular phone. It would have been obvious to one of ordinary skill in the art to allow Barker to delivery a notification by these commonly known method (via email or over a cellular phone) so that the recipient can quickly and economically receive a notification.

As to claim 23, converting a sent electronic document folder into a page description language before sending a link to the electronic document folder to a recipient is taught by Barker as fragment the document to smaller sizes before delivering it a recipient (column 3 lines 26-29 and Fig. 1).

As to claim 27, Barker teaches at least one of device is from the group comprising a scanner, a facsimile machine, and a computer (Fig. 1).

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As to claim 28, Barker teaches the receiving device is from the group comprising a web-enabled personal computer, a web-enabled printer, a web-enabled digital copier, and a web-enabled Internet appliance (Fig. 1).

Claims 24-26, 29-30 and 38 are rejected for the similar reasons as claims 1, 5, 8, 10 and 23.

7. Claims 6-7, 11-16 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Miller et al., U. S. Patent 6,151,696, and in further view of Kovnat et al., U. S. Patent 5,619,649.

As to claim 6, Barker modified by Miller teaches folder code as discussed above. Barker does not specifically teach the folder code is a privacy code. The privacy code is taught by Kovnat as a pin number. Kovnat teaches each information (job) is assigned to a pin number, and user needs to the pin number to retrieve the information (Figs. 16-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the folder code (or the indirect reference) of Barker to be a pin number so that only the authorized user can retrieve the information.

As to claim 7, Barker modified by Miller teaches folder code as discussed above. Barker does not specifically teach the folder code is a mediacard data, said media card data delivered to each recipient prior to said recipient's accessing an electronic document folder. Kovnat teaches each information (job) is assigned to a pin number, and user needs to the pin number in order to access the information (Figs. 16-17). Kovnat does not specifically teach the pin number is mediacard data; however, it well known in the art the pin number is can be issue on paper, on a card, or through email,

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etc. It would have been obvious to one of ordinary skill in the art to allow the pin number to be issue on a mediacard so that the recipient can carry around for remotely accessing the information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the folder code (or the indirect reference) of Barker to be a media data so that only the authorized user can retrieve the information.

As to claims 11-14, Barker modified by Miller does not specifically teach authentication step. However, Kovnat teaches authentication step (Figs. 16-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include the authenticate step for better securing the information.

As to claim 15, Barker modified by Miller does not specifically teach at least one document within a sent document folder has a printable representation. However, Kovnat teaches this matter. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow to method of Barker to include a printable document so that some of information can be printed for better viewing.

As to claim 16, Barker modified by Miller teaches does not explicitly teach at least one document folder comprises exactly one document. However, this matter is taught by Kovnat as each transmitted packet has a limited size (column 7 lines 33-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include at least one document folder comprises exactly one document so that some of the documents do not need fragmentation if the size of the document is small.

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Claim 37 is rejected for the similar reasons as claims 11-14.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Miller et al., U. S. Patent 6,151,696, and in further view of Walker et al., U. S. Patent 5,862,223.

As to claim 18, Barker modified by Miller does not specifically teach charging a recipient upon the recipient's taking delivery of an electronic document folder when the electronic document folder has been sent C. O. D. However, this matter is taught by Walker as a C. O. D. system that requires recipient to pay prior to delivery (column 22 lines 12-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the method of Barker to include the C. O. D. system so that the sender can be surely paid.

9. Claims 19-20 and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al., U. S. Patent 6,233,252 in view of Miller et al., U. S. Patent 6,151,696, and in further view of Griswold, U. S. Patent 5,940,504.

As to claims 19-20, Barker modified by Miller does not specifically teach charging the recipient when the document folder has been stored on a network beyond an agree-upon period of time. Griswold teaches the license is expired is the present date is greater than license termination date (Fig. 7). Griswold does not specifically state charging the user if the product is used beyond the license termination date. It would have been obvious to one of ordinary skill in the art to allow Griswold to charge the user if the product is used beyond the license termination date so that the licensing owner can be better compensated. It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to allow the method of Barker to include charging recipient if the document is used beyond an agreed period of time so that the sender can be better compensated.

As to claim 34, the method of Barker modified by Griswold does not specifically teach sending C. O. D. It would have been obvious to one of ordinary skill in the art to allow the modified method to include sending C. O. D. so that the sender can be surely paid.

Claims 31-33 and 35-36 are rejected for the similar reasons as claims 19-20.

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Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
July 12, 2004

